UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,351	07/08/2003	Masaya Higuchi	JP920020086US1	8902

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EXAMINER
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ART UNIT	PAPER NUMBER
2151	

NOTIFICATION DATE	DELIVERY MODE
10/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *10 July 2007*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *14-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *14-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This action is in responsive to amendments filed on July 10, 2007.

Claims 14-23 are presented for examination.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21 and 22 both try to claim usable program codes that lack an appropriate computer readable storage medium to define a structural and functional interrelationship between a computer program and other elements of the computer.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 14, 15, 16, 18, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by <u>Powlette</u> U.S. Patent Application Publication Number 2006/0143200.

5.   As per claims 14, 16, and 19-22, Powlette discloses a client for use in a

client/server system, the client comprising: a web browser subsystem for requesting a

program from a remote server, retrieving the program, executing the program and

displaying data resulting from execution of the program at the client (see remote data

applet download and execution on page 2 section [0017]); detection logic for detecting

an input instruction to print an image being displayed at the client (see receiving data at

server from remote program on page 3 section [0050] and using modified file from

server to print on local system on page 3 section [0053]); logic responsive to detectinput

print instruction to generate printing information (see generating modified information for

remote server on page 3 section [0050]); transmit logic for transmitting the generated

printing information to a web application server connected to the client, said web

application server being distinct from the remote server (see sending modified data to

remote server on page 3 section [0032]-[0035]); receiving logic for receiving information

generated by the web application server as a response to the receipt of generated

printing information provided by the client (see returning modified data file to local

computing system on page 3 section [0036]); and output logic for outputting the

received information to a printing system connected to the client (see sending modified

file to local printer on page 3 section [0053]).

6.   As per claim 15, <u>Powlette</u> discloses a client of claim 14 wherein the program

retrievedfrom the remote server is a Java applet (see Java applet on page 2 section

[0017]).

7.   As per claim 18, <u>Powlette</u> discloses the web application server of claim 16 further

including: data storage for storing form data produced by the print preparation

subsystem (see storing on local file system on page 3 section [0053]); and image

processing logic for preparing image data for printing (see send to printer on page 3

section [0053]).

8.   As per claim 23, <u>Powlette</u> discloses the computer program product of claim 22

wherein the computer usable program code configured to process received printing

information to prepare a print file having a predetermined print format further comprises:

computer usable program code configured to process image data identified in the

received printing information (see visual image data on page 2 section [0016]); and

computer usable program code configured to process text data identified in the received

printing information (see modification to the initial data on page 2 section [0024]).

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Powlette</u>

as applied to claim 16 above, and further in view of <u>Lloyd et al.</u> U.S. Patent Number

6,779,178 B1 (hereinafter <u>Lloyd</u>).

11.   As per claim 17, <u>Powlette</u> does not disclose expressly the data for printing is a

portable document format (PDF) file. <u>Lloyd</u> teaches the use of PDF files for transferring

printer independent documents over the Internet (see column 12 line 40-45). <u>Powlette</u>

abd <u>Lloyd</u> are analogous art because they are from the same field of endeavor, remote

modification of data files. At the time of the invention it would have been obvious to a

person of ordinary skill in the art to use PDF file as one of the formats to save the data

for printing. The motivation for doing so would have been to use a printer independent

document format that the defacto standard for the Internet. Therefore, it would have

been obvious to combine <u>Powlette</u>'s remote file printing system with <u>Lloyd</u>'s PDF format

for printing data to obtain the invention as specified in claim 8.

12.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

a) System and Method for Permitting a Software Routing Having Restricted Local

Access to Utilize Remote Resources to Generate Locally Usable Data Structure by

Powlette, U.S. Patent Number 6,489,954 B1.

b) System and Method for Annotating & Capturing Chart Data by Powlette, U.S. Patent

Application Publication Number 2002/0018077 A1.

c) Web Print System with Image Enhancement by Ichikawa et al., U.S. Patent Number

6,914,694 B1.

d) Method and System to Print via Email by Treptow et al., U.S. Patent Number

6,993,562 B2.

Response to Arguments

13.   Applicant's arguments filed on July 10, 2007 have been fully considered but they

are not persuasive. The applicant asserts that Prowlette does not disclose the use of a

client-connected web application server that can be used to process client-originated

print requests based on execution of a program received from a remote server and

returning a printable file to the client (see Remarks on page 10). The examiner

disagrees. Prowlette disclose the transfer of modified files to remote servers from the

client (see page 2 section [0024]) and return the modified files back to the client for

printing (see page 3 section [0053]).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chou whose telephone number is (571) 272-5779. The examiner can normally be reached on 7am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571)272-3440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

AC

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